

Atty Docket No.: 10013014-1
Application No.: 09/992,666

Remarks

This Election is responsive to the Restriction Requirement issued of October 9, 2008. Applicant respectfully requests reexamination and reconsideration of the present application.

Summary of The Restriction

Restriction to one of the following inventions was required under 35 U.S.C. 121:

- I. Claims 1-5 and 20-23, drawn to a method and system for configuring data communication paths, classified in class 709, subclass 238.
- II. Claims 6-11, drawn to a method for gathering diagnostic data, classified in class 709, subclass 223.

Election

In response to the Restriction Requirement, Applicant elects to prosecute Group I, claims 1-5 and 20-23, **with traverse**. Furthermore, a Petition to the Director to review the restriction is filed concurrently herewith.

Arguments for Traverse

The examiner now restricts the claims for the first time even though six (6) office actions have been issued and two (2) appeal briefs filed. No RCE's have been filed. The examiner cites 37 CFR 1.142(a) as a basis for such a delayed restriction but misses the entire sentence that reads, "Such requirement will

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normally be made before any action on the merits" (emphasis added). Although the text states, "however, it may be made at any time before final action," this usually means before the first final action. The present case has already had three (3) final actions and no RCE's have been filed.

There is simply no justification for the restriction at this point in prosecution. If after six Office Actions, no references have been found that teach or suggest the claims, then it is time to allow the case, not re-start prosecution with a restriction. Such a restriction is quite frankly unacceptable.

The Restriction Is Improper

The basis for the restriction is MPEP 806.05(d), which reads:

806.05(d) Subcombinations Usable Together [R-5]

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.

MPEP 806.05(d) requires three (3) conditions to be proven by the examiner:

- (1) subcombinations can be shown to be separately usable;
- (2) the subcombinations do not overlap in scope; and
- (3) the subcombinations are not obvious variants.

The present restriction simply provides an argument for condition (1), but fails to provide any evidence or rationale for conditions (2) and (3). Therefore, a prima facie case for the propriety of the restriction requirement has not been presented. Thus, the restriction is improper and should be withdrawn.

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Comparing independent claim 1 and independent claim 6, they do overlap in scope. Thus a restriction is not proper under MPEP 806.05(d). For example, claim 1 recites an element that begins, "for each of the printing devices, determining communication capabilities..." This overlaps with the language of claim 6 that reads, "determining which of the plurality of intermediate collectors are capable of communicating..." Claim 1 also recites, "transmitting signals indicative of the communication capabilities to the central controller." This overlaps with the language of claim 6 that reads, "receiving a notification signal within the central processing unit that one of the intermediate collectors is available." The scope of the "mapping" element of claim 1 also overlaps with language of claim 6 that begins, "to obtain a communication map to allow..."

Therefore, the conditions for a proper restriction under MPEP 806.05(d) have not been met by the Office Action. The restriction is improper and should be withdrawn. All claims should now be allowed.

Respectfully submitted,



Peter Kraguljac (Reg. No. 38,520)

(216) 503-5500

Kraguljac & Kalnay, LLC
4700 Rockside Road
Summit One, Suite 510
Independence, OH 44131